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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 833,507	04 11 2001	Ralph A. Mosher	D.A0584Q	2992

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EXAMINER

YOON, TAE H

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/18/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

29/33,507

Applicant(s)

Mosher et al.

Examiner

T. Yoon

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 2-27-03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 3-6, 8-18, 20 and 21 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☒ Claim(s) 21 is/are allowed.
- ☒ Claim(s) 1, 3-6, 8-13, 15, 17, 18 and 20 is/are rejected.
- ☒ Claim(s) 14-16 is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 8, 9, 11, 17 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kitajima et al (US 4,555,274).

Kitajima et al teach a layered product comprising a conductive layer in figures and at col. 4, lines 35-42 wherein a conductive layer 11 is positioned between two substrates. Conductive layers of various fillers and binders including an alcohol-soluble polyamide is taught at col. 9, line 16 to col. 10, line 3. Thus, the instant invention lacks novelty.

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Claims 1, 8-12, 15, 17 and 18 are rejected under 35 U.S.C. 103(a) as obvious over Kitajima et al (US 4,555,274) in view of Yazami et al (US 6,358,649) or Ito (US 6,475,670).

The instant invention recites other conductive fillers and crosslinking over Kitajima et al. However, the instant conductive fillers are well known in the art as taught by Yazami et al (fluorinated carbon, abstract and example) and Ito (conductive polymers, col. 3, lines 6-21). Also, crosslinking of adhesives to enhance physical properties is a routine practice.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the art well known conductive fillers of Yazami et al or Ito in Kitajima et al since Kitajima et al teaching employing any material for constructing the electrodes at col. 9, lines 12-15.

Claims 1, 3-6, 8, 9, 11, 15, 17, 18 and 20 are rejected under 35 U.S.C. 103(a) as obvious over Kitajima et al (US 4,555,274) in view of Nakamura et al (US 5,923,925) or Kamosaki et al (US 3,932,340).

The instant invention further recites an alcohol-soluble polyamide having alkoxy alkylene pendant groups over Kitajima et al. However, such alcohol-soluble polyamide is well known in the art as taught by Nakamura et al (col. 8, lines 15 and 21 and CM-8000 of example 1) and Kamosaki et al (col. 1, lines 9-19 and example 1).

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the art well known alcohol-soluble polyamide having alkoxy alkylene pendant

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groups of Nakamura et al or Kamosaki et al in Kitajima et al since Kitajima et al teaching employing an alcohol-soluble polyamide and since said alcohol-soluble polyamide having side chain is well known in the art.

Claims 1, 3-6, 8, 9, 11, 13, 17, 18 and 20 are rejected under 35 U.S.C. 103(a) as obvious over Jung et al (US 5,728,181) in view of Nakamura et al (US 5,923,925) and/or Kitajima et al (US 4,555,274).

Jung et al teach the adhesive comprising a polyamide and electrically conductive filler at col. 3, lines 43-61. The instant invention further recites an alcohol-soluble polyamide over Jung et al. However, the polyamide of Jung et al encompasses said alcohol-soluble polyamide, and the use of an alcohol-soluble polyamide as an adhesvie is well known the art as taught by Nakamura et al (col. 8, lines 15 and 21 and CM-8000 of example 1). Said CM-8000 is taught at page 16, line 12 of the specification. Kitajima et al teach employing said alcohol-soluble polyamide as a binder at col. 9, line 40 to col. 10, line 3 in making an electrode.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize an alcohol-soluble polyamide of Nakamura et al or Kitajima et al in Jung et al since Jung et al teach a polyamide adhesive and since the use of an alcohol-soluble polyamide as an adhesvie is well known the art.

The use of the art known polymer such as an alcohol-soluble polyamide in the well known application such as coating or adhesives is a *prima facie* obviousness.

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Claims 1, 3-6, 8, 11, 17, 18 and 20 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Katayama et al (US 6,136,484).

Katayama et al teach the instantly bonded article wherein an adhesive comprising an alcohol-soluble polyamide (CM8000) and electrically conductive fillers in example 11 and Figs. 1A and 1B. The instant volume resistivity is an inherent property of said conductive layer.

Thus, the instant invention lacks novelty.

Claims 14 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 21 is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/March 10, 2003



TAE H. YOON
PRIMARY EXAMINER